

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant:	Bresniker et al.	Patent Application
Application No.:	10/678,464	Group Art Unit: 3689
Filed:	October 3, 2003	Examiner: Nguyen, T. T.
For:	RACK EQUIPMENT MANAGEMENT INFORMATION COORDINATION SYSTEM AND METHOD	

REPLY BRIEF

Appellants respectfully submit the following remarks in response to the Examiner's
Answer, which was mailed on August 30, 2010.

REMARKS

Appellants respectfully submit the following remarks in response to the Examiner's Answer. In these remarks, Appellants address certain arguments presented in the Examiner's Answer. While only certain arguments are addressed in this Reply Brief, this should not be construed to mean that Appellants agree with the other arguments presented in the Examiner's Answer.

(§6) Grounds of Rejection to be Reviewed on Appeal, pages 2-5 of Examiner's Answer

In this section, a new ground of rejection has been added. Namely, Claim 17 has been newly rejected under 35 U.S.C. § 112, paragraph 2, "...as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." In particular, this new ground of rejection in the Examiner's Answer appears to take issue with the feature of "a means for controlling automatic retrieval of rack equipment related information ..." and the "a means for processing information and instructions. The Examiner's Answer contends that,

It appears that the rack equipment information is controlled by a retrieval module 321, and the characteristics of the rack equipment is processed and managed by a "repository management component 320". However, the specification does not describe how the rack equipment information is controlled, processed, and managed. Specifically the specification does not provide the algorithm for the claimed means for controlling, processing as such the appellants have failed to adequately describe sufficient structure for performing the functions claimed.
(see page 5 of Examiner's Answer)

Appellants respectfully disagree that Claim 17 is indefinite.

As described in the Appeal Brief (§V. Summary of Claimed Subject Matter) Appellants submit that the structure and function of “a means for controlling automatic retrieval of rack equipment related information ...” is described at a number of locations in the specification and figures, including: system 300 and description retrieval module 321 of Figure 3; page 13, lines 15-25; page 9, lines 2-11; and computer system 400 of Figure 4; and page 15, lines 11-19. Appellants submit that these recited portions satisfy the requirements of 35 U.S.C. §112, paragraph 2, with respect to this claimed means + function feature, and thus overcome this first portion of this new ground of rejection.

As described in the Appeal Brief (§V. Summary of Claimed Subject Matter) Appellants submit that the structure and function of “a means for processing information and instructions...” is described at a number of locations in the specification and figures, including system 300 and repository management component 320 of Figure 3; page 10, line 23-page 11, line 2; and page 12, lines 16-25. Appellants additionally submit that further description of this feature can be found at least at: Page 12, line 25 - page 13, line 25; page 15, line 1 - page 16, line 7; and Figure 4 (e.g., processor 451, memory 452, input component 453, and communications port 459) Appellants submit that these recited portions satisfy the requirements of 35 U.S.C. §112, paragraph 2, with respect to this claimed means + function feature, and thus overcome this additional portion of this new ground of rejection.

Appellants respectfully request that this case continue in appeal and that the Board be the arbiter of the validity of this new ground of Rejection.

(§9) Grounds of Rejection, pages 6-20 of Examiner's Answer

Appellants have reviewed this portion and note that it has been altered from the most recent office action in that several of the cited portions of O'Kane Jr. art (US 6,336,919) have been newly added or changed, apparently in response to the arguments presented in the Appellants' Appeal Brief. For example, the material at page 7, line 15 - page 8, line 6; page 8, lines 13-16; page 9, lines 11-19; and page 12, lines 11-14 all appears to be newly added or altered since the previous Office Action. Additionally, it appears that the Examiner's Answer continues to misrepresent *In re Gulack*, 703 F.2d 1381, 1395, by parsing a phrase and citing it out of context with the holdings of the case. A discussion of Appellants perspective on *In re Gulack* is included in the Appeal Brief and reference is made thereto.

With respect to page 7, line 15 - page 8, line 2 of the Examiner's Answer, Appellants submit that the newly added arguments of this portion of the Examiner's Answer were addressed at least on page 14 of the Appeal Brief.

With respect to page 8, lines 3-6 and 13-16 of the Examiner's Answer, Appellants submit that the newly added arguments of this portion of the Examiner's Answer have no bearing on the portions of the rejections of the rejected claims which are being argued in the Appeal Brief.

With respect to page 9, lines 11-19 of the Examiner's Answer, Appellants submit that the newly added arguments of this portion of the Examiner's Answer were addressed at least by pages 15-17 of the Appeal Brief where there is a discussion of the Office Action's characterization of certain claim features as Non-Functional Descriptive Material (NFDM).

With respect to page 12, lines 11-14 of the Examiner's Answer, Appellants submit that the newly added arguments of this portion of the Examiner's Answer were addressed at least on pages 18-20 of the Appeal Brief. Further, Appellants submit that this additionally cited portion of O'Kane still does nothing to teach "a repository management component that controls automatic retrieval of said equipment description information and said management plan information such that said identification of equipment type is automatically retrieved by said repository management component from said at least one component of said rack of equipment," (emphasis added) as is recited in Claim 8. This is because nothing indicates that equipment description information is automatically retrieved from a component; rather, only operational information appears to be retrieved.

(§10) Response to Argument: pages 20-27 of Examiner's Answer

The Examiner's Answer again cites to O'Kane's retrieval of operation information and then excludes Appellants' Claim language "identification of equipment type" from examination by perfunctory classification of this language as Non-Functional Descriptive Material (NFDM) (see points 1 and 2 on pages 22 and 23). Appellants submit that both of these arguments have been

addressed in the Appeal Brief and that the Examiner's Answer brings nothing new to the table with respect to these issues.

In sub-point 3 of point I, page 23, the Examiner's Answer provides a discussion "[f]or sake of argument, assuming the data 'an identification of equipment type is functional...'" However, again the Examiner's Answer merely points out that O'Kane teaches automatic retrieval of operational information. The Examiner's Answer correctly indicates that col. 4, lines 41-50 discusses manual retrieval of equipment identification information, and then contends that automatic retrieval of this equipment identification information is disclosed as an alternative. However, the Examiner's Answer provides no citation for where this alternative teaching exists. With respect to the citation to MPEP2144.04, section 3 regarding automation, Appellants submit that this citation is inapplicable as a mechanical activity is not having automation added as was the case in the *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

With respect to point II on pages 24-26, Appellants disagree and refer to the arguments presented in the Appeal Brief. Appellants respectfully request that the Board direct examination of all portions of our claim, and prevent the parsing of the claim language which has been perfunctorily categorized as functional and thus not required to be examined.

With respect to point III on pages 26 and 27, Appellants disagree and refer to the arguments presented in the Appeal Brief with respect to these claims. Additionally, Appellants submit that it is incorrect to cite to MPEP 2141.02, section VI and contend that a piece of art must

criticize, discredit or otherwise discourage a claimed solution in order to teach away. Firstly, this is a selective, and misleading parsing of only a portion of cited language. The full quote is: “However, ‘the prior art’s mere disclosure of more than one alternative’ does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...” *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). (underlining indicates parts which were selectively omitted in the Examiner’s Answer). Appellants submit that this citation is inapplicable to O’Kane as O’Kane doesn’t present alternatives to the manual collection of equipment identification information -- instead it requires that such manual collection. Secondly, the O’Kane art specifically requires a manual survey to collect equipment identification information (see col 4, lines 40-54 of O’Kane). Appellants submit that when manual collection of equipment identification information is described (required) in conjunction with a system that has abilities to collect operation information remotely from equipment (but not equipment identification information without an initial manual survey), this leads to the conclusion that O’Kane teaches away from automatic collection of equipment identification information.

CONCLUSION

For reasons presented above and for reasons previously presented in the Appeal Brief, Appellants continue to assert that the embodiments of Claims 1-20 are not taught suggested or described by the cited art. Thus, Appellants respectfully request that the rejections of Claims 1-20 be reversed.

Appellants encourage the Examiner or a member of the Board of Patent Appeals to telephone the Appellants' undersigned representative if it is felt that a telephone conference could expedite prosecution.

Respectfully submitted,

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Dated: 11/1/2010

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